

REMARKS

The Applicant thanks the Examiner for his detailed comments. Amendments have been made to the abstract, specification, claims, and drawings. Claim 6 has been cancelled. Entry of the Amendments is respectfully requested.

Restriction Requirement

The Applicant disagrees and again traverses the Examiner's restriction requirement, since all of the claims as filed and pending in this application depend from one generic joint prosthesis claim, as recited in claim 1. Claim 7 has been amended to depend from claim 1. Claim 6 is cancelled.

MPEP 806.04(d) states that once a generic claim is allowed, all claims drawn to species in addition to the elected species will ordinarily be obviously allowable in view of the allowance of the generic claim since the additional species will depend thereon or otherwise include all of the limitations thereof.

Specification

In response to paragraph 3 in the examiner's detailed action, an updated cross-reference to related applications has been provided. A copy of the transaction history for the parent application which is attached and shows a preliminary amendment of July 17, 2002, which is apparently the date received by the USPTO. No new matter has been added. ✓

Brief Description of the Drawings

A brief description for figures 35-57 has been added by amendment in response to paragraph 3. No new matter has been added.

Replacement Drawings

In response to paragraph 4 of the Examiner's detailed action, a replacement sheet of drawings for Figures 38A through 38C has been provided. Figure 38C now describes an example of two arcuate curves J and K.

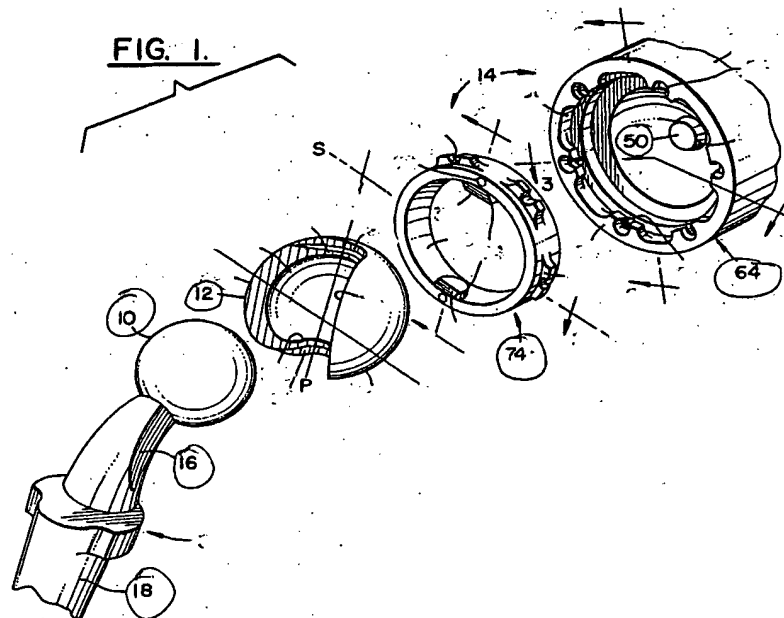
Formalities

With respect to the objection for informalities in paragraph 5, claims 1, 8 and 10 have been amended to incorporate the Examiner's comments. With respect to claim rejections under 35 U.S.C. §112, paragraph 2, the elements of the claims as amended are not indefinite.

Anticipation

With respect to the rejections under 35 U.S.C. §102 in paragraph 9, the amended claims are not anticipated by the cited reference. In order to anticipate a claim, a reference must disclose each and every element of a claim exactly. DeCarlo, US Patent No. 4,524,467, does not disclose a "segmented shell ... a second shell fixedly retained with ... said segmented shell [and] a cup ... being sized and configured to be fixedly retained in said second shell."

DeCarlo does not disclose a shell and a cup that is fixedly retained. Instead, DeCarlo discloses a socket bearing 12 that is pivotably retained by ring 74 in cup 14. See the figure below and column 5, lines 59-65 of DeCarlo. If the cup 14 is considered a segmented cup, then there is no shell, as that term is recited in claim 1. If socket bearing 12 is considered a cup, then the cup is not fixedly retained in the shell. Thus, DeCarlo fails to disclose each and every element of the claim exactly; therefore, claim 1 is not anticipated by DeCarlo.



Non-obviousness

In order to establish *prima facie* obviousness over the claims of the invention, a reference must teach or suggest every limitation of the invention. None of the cited references teach or suggest the limitations of the independent claims.

Claim 10 depends from claim 1 and incorporates all of the limitations of claim 1; therefore, Grimes fails to establish *prima facie* obviousness over claim 10. Specifically, Grimes fails to teach or suggest a cup “being sized and configured to be fixedly retained in said second shell” As previously mentioned, Grimes instead teaches a pivotably mounted socket bearing 12. Furthermore, Grimes fails to teach or suggest a segmented shell, as that term is claimed in claim 1. Accordingly, Grimes fails to establish *prima facie* obviousness over claim 10.

Claim 11 depends from claim 10 incorporating all of the limitations of claim 10 and additional limitations. Therefore, Grimes fails to establish *prima facie* obviousness over claim 11.

Claims 2 and 8 have been amended to place these claims in independent form. As the examiner indicated that these claims would be allowable if placed in independent form, claims 2 and 8 are now in condition for allowance.

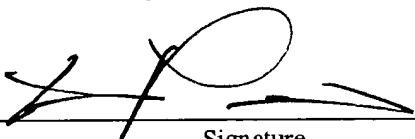
Accordingly, Hyde, Jr. as well as Grimes fail to establish *prima facie* obviousness over claims 10 and 11.

The amendments to the claims, specification, abstract and drawings now put the application in condition for allowance. The Applicant respectfully requests that the Examiner enter the amendments and indicate allowance of the claims that are now pending in this application.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 13, 2005

Christopher Paradies

Name of applicant, assignee or
Registered Representative



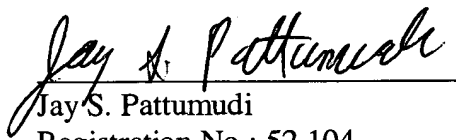
Signature

April 27, 2005

Date of Signature

JSP:kat
Enclosures

Respectfully submitted,



Jay S. Pattumudi

Registration No.: 52,104

FOWLER WHITE BOGGS BANKER

501 East Kennedy Blvd., Suite 1700

Tampa, Florida 33602

#1702343v1



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz Alerts](#) | [News](#) | [Help](#)

Portal Home

Patent Applications

[Patent Application Information \(PAIR\)](#)[PAIR Frequently Asked Questions](#)[PAIR Help](#)[Search Class/Subclass/GAU](#)[Manual of Patent Classification](#)[Secure eBusiness](#)[Patent EBC](#)[Customer Numbers](#)[Digital Certificates](#)[Electronic Filing](#)[Private PAIR](#)[Glossary](#)[Patent eBusiness Support/Help](#)[System Alerts](#)[Viewer Download: PDF](#)

Patent Information

[About Patents](#)[Manual of Patent Examining Procedure](#)[Patent Assistance Center](#)[Employee Locator Search](#)[Valid Location Codes](#)[Telephone Directory](#)[Fees](#)[Pay online \(RAM\)](#)[Inventor Resources](#)[News, Federal Register & OG Notices](#)[PTDL Program](#) - libraries near you[Registered Patent Attorneys & Agents](#)

Patent Searches

[Search Patents/Patent Applications](#) - full text & images[How to View Patent Images](#)[Search Assignments](#) - ownership[Search International Patents](#)[Other Search Resources & Tips](#)[Sequence Searches](#) (biotech)[Software for Sequence Listings](#)[Order Copies & Publications](#)[Products & Services](#)

Other

| -

Patent Application Information Retrieval

Select Search Method: Enter Number:

Application Number **SUBMIT**

09/961,662 JOINT PROSTHESIS AND METHOD FOR PLAC

Application Data	Transaction History	Patent Term Adjustments	Continuity Data	Published Documents	Fees
		Date	Center		
		06-29-2004	Recordation of Patent Grant		
		06-10-2004	Issue Notification Mailed		
		06-29-2004	Patent Issue Date Used in PT		
		05-07-2004	Receipt into Pubs		
		05-06-2004	Application Is Considered Re		
		04-30-2004	Issue Fee Payment Verified		
		09-24-2001	Workflow - Drawings Finishe		
		09-24-2001	Workflow - Drawings Matched		
		04-30-2004	Issue Fee Payment Received		
		03-11-2004	Receipt into Pubs		
		02-13-2004	Receipt into Pubs		
		02-12-2004	Workflow - File Sent to Contrac		
		02-12-2004	Receipt into Pubs		
		02-10-2004	Dispatch to Publications		
		02-10-2004	Issue Revision Completed		
		02-05-2004	Mail Notice of Allowance		
		02-04-2004	Notice of Allowance Data Ver		
		02-04-2004	Notice of Allowability		
		11-18-2003	Date Forwarded to Examiner		
		11-03-2003	Response after Non-Final Actio		
		10-14-2003	Mail Notice of Informal or No		
		10-12-2003	Date Forwarded to Examiner		
		10-06-2003	Informal or Non-Responsive		
		10-06-2003	Response after Non-Final Actio		
		07-02-2003	Mail Non-Final Rejection		

[Copyrights](#)[Policy & Law](#)[Reports](#)[Trademarks](#)

06-24-2003	Non-Final Rejection
04-19-2003	Date Forwarded to Examiner
03-27-2003	Response to Election / Restrict
02-20-2003	Mail Notice of Informal or No
12-18-2002	Date Forwarded to Examiner
12-13-2002	Informal or Non-Responsive
12-13-2002	Response to Election / Restrict
11-26-2002	Mail Restriction Requirement
11-26-2002	Requirement for Restriction / E
07-17-2002	Preliminary Amendment
12-31-2001	Information Disclosure Stateme
01-03-2002	Case Docketed to Examiner i
09-24-2001	Information Disclosure Stateme
12-13-2001	Case Docketed to Examiner i
11-07-2001	Application Dispatched from Ol
11-05-2001	Correspondence Address Ch
10-02-2001	IFW Scan & PACR Auto Secur
09-24-2001	Initial Exam Team nn
09-24-2001	Initial Exam Team nn

The Patent Electronic Business Center is available to assist with PAIF

[Home](#) | [Site Index](#) | [Search](#) | [eBusiness](#) | [Help](#) | [Privacy Policy](#)